

Remarks

Note: The following headings relate to the headings within the Office Action.

Priority Document

The Priority Document has been ordered and will be submitted when it is received.

Information Disclosure Statement

The Office Action notes that DE 198 55 158 A1 was not considered because there was no date provided. It should be noted that DE 198 55 158 A1 was not published. It was the priority application for DE 199 29 701, which was published June 29, 1999. A copy of DE 199 29 701 is enclosed.

Claim Rejections Under 35 USC 112

Claims 23 and 24 are amended to provide an antecedent basis for “said vertex radius (R)” by changing these claims to depend upon claim 22.

Claim Rejections Under 35 USC 102

Claims 5-10 are rejected as being anticipated by the patent to Sasaya et. al. (Sasaya).

Claims 1, 5-11, 15, 25-27 and 33 are rejected as anticipated by the patent to Yamaguchi et. al. (Yamaguchi).

Claim 22 is rejected as being anticipated by the patent to Araki.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. “For anticipation under 35 USC 102, the reference must

teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” MPEP 706.02(a).

Sasaya, Yamaguchi, or Araki do not disclose each of the features of the rejected claims as now amended.

To distinguish the present invention from the prior art we have added to the rejected claims that all lenses of the 4th lens group consist of lenses with spherical surfaces. In Yamaguchi in all examples the 4th lens group comprise lenses with aspherical surfaces.

In Sasaya only the last lens surface is aspherical. Thus, the present invention is not disclosed by Sasaya.

Anaki discloses only projection objectives comprising only a small number of lenses. None of the disclosed examples has a structure with six lens groups. Further, the projection objective shown in Fig. 1 comprises aspherical lenses in lens group four.

Claim Rejections Under 35 USC 103

Claims 17, 18, and 20 are rejected as unpatentable over Yamaguchi in view of Sasaya.

Valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court of Appeals for the Federal Circuit (*Ecolchem inc. v Southern California Edison Co., Fed. Cir.*, No. 99/1043, 9/7/00).

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.

Yamaguchi and Sasaya do not motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

Recently, in *In Re Sang-Su Lee* (00-1158) the Court of Appeals for the Federal Circuit rendered a decision confirming the above principles. The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

"Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.

"The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decision making."

Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.

"As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC § 103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

(Emphasis added)

“The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. Our case laws makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made y the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so.”

As discussed above, Yamaguchi and Sasaya do not disclose the features of the present invention. Thus, their combination does not disclose the features of the present invention, and these references do not motivate or suggest to one skilled in the art to combine these references to produce Applicant’s claimed invention.

Specifically, Yamaguchi and Sasaya do not suggest to a skilled person to combine these references to produce the features of claims 17, 18 or 20.

Double Patenting

A Terminal Disclaimer is submitted herewith to overcome any concerns for double patenting with application US 2002/0008861 A1 (US 09/847,658).

Allowable Subject Matter

The claims 2-4, 12-14, 16, 21 and 29-32 are considered allowable when rewritten in independent form, including all of the limitations of the base claim and any intervening claims. Claims 33-44 satisfy this requirement.

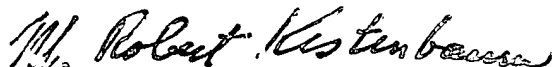
Certified Priority Document

A Certified Priority Document for 199 22 209.6 is enclosed herewith.

Wherefore, please further consider and allow the claims as now amended.

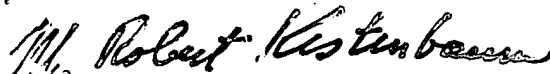
A three-month extension of time in which to respond to the outstanding Office Action is hereby requested. Please charge \$786 (additional claim fee - 11 additional claims over 20 = \$198 and 7 additional independent claims over 3 = \$588) in addition to \$930 for a three-month Large Entity extension fee and also the \$180 Information Disclosure Statement fee for a total of \$1896. Enclosed is a credit card authorization for \$1896. Any other fee due by virtue of this filing or this application should be charged to Deposit Account 11-0665 . Any refunds in connection with this filing should be credited to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,



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I hereby certify this correspondence is being deposited with the US Postal Service as first class mail in an envelope addressed to Commissioner for Patents, PO Box 1450, Alexandria, VA, 22313-1450 on May 27, 2003.



M. Robert Kestenbaum